

REMARKS

A Notice of Appeal is being filed concurrently herewith.

The rejection of claims 1, 3, and 8-12 under 35 USC 102 as being anticipated by Izumi et al. (US 5,307,186) is respectfully traversed. The Examiner asserts that the claimed x,y color coordinates are an inherent property of the EL phosphor disclosed by Izumi. The Applicant respectfully disagrees. Neither the general composition of the EL phosphor of Izumi et al. nor the general term "yellow" is specific enough to anticipate the range of y color coordinates claimed by the Applicant. For example, U.S. Patent 5,009,808 to Reilly et al. which is of record in this application teaches yellow-emitting ZnS:Mn,Cu,Cl phosphors. (Col. 1, lines 1-19) Of the specific phosphors listed in Table II of Reilly et al., all nine test samples have y color coordinates above the Applicant's claimed upper limit of 0.440. The lowest y color coordinate taught by Reilly is 0.457.

In order to support a rejection based on inherency, it must be established that the missing characteristic is necessarily present in the prior art.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). MPEP §2112

By demonstrating that the yellow-emitting ZnS:Mn,Cu,Cl phosphor of Reilly et al. does not possess a y color coordinate within the range claimed by the Applicant, the Applicant respectfully asserts that the Applicant has shown that the missing y color coordinate is not

necessarily present in Izumi et al. and therefore cannot be deemed to be inherent. Thus, the Applicant respectfully asserts that the claimed invention is not anticipated by Izumi et al.

The rejection of claim 4 under 35 USC 103(a) as being unpatentable over Izumi et al. in view of Menkara et al. (US 2005/0023546) is respectfully traversed. The Applicant's above arguments with respect to Izumi et al. are reasserted here. In view of the fact that neither reference teaches or suggests the claimed y color coordinate range, the Applicant respectfully asserts that the claimed invention is not obvious in view of Izumi et al. and Menkara et al.

In view of the foregoing remarks, it is believed that the Examiner's rejections have been overcome and that the application is in condition for allowance. Such action is earnestly solicited.

Respectfully submitted,

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